



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,906	01/07/2004	Jason M. Mayeroff	MAYEROFF03-03	5647
52396	7590	12/13/2005	EXAMINER	
MORISHITA LAW FIRM, LLC 3800 HOWARD HUGHES PARKWAY SUITE 850 LAS VEGAS, NV 89109			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,906

Applicant(s)

MAYEROFF, JASON M.

Examiner

Kim T. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of the amendment on 9/30/05. According to the amendment, claims 15-21 are pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "the frequency with which a secondary game is triggered is constant and predetermined with the prompting of each play" in claim 15 contains new matter that is not disclosed in the disclosure as originally filed.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminkow (US 2005/0026678) in view of Glavich (US 6,309,300).

Claims 15-17: Kaminkow discloses an electronic gaming apparatus comprising a processor; a primary game display; means for a player to make a wager; the processor randomly select and display indicia at the primary game display, if the outcome is a winning outcome, issue an award (Fig. 7; paragraphs 0029, 0031 and 0035); Kaminkow further discloses that a mechanical secondary game display separated from the primary game display displays awards prior to the selection of the secondary game trigger condition, and that the secondary game identifies the selection of award and awards the player would have been known in the art (paragraphs 0005). Kaminkow does not explicitly disclose randomly select between the secondary trigger and no trigger condition independently of the primary game outcome, such that the frequency with which a secondary game is triggered is constant and predetermined with the prompting of each play. Glavich does not explicitly disclose setting a predetermined constant frequency for triggering the secondary game. However, Glavich discloses triggering secondary game in response to passage of a certain amount of time (col. 3, lines 54-57). Since it would have been well known that the primary game can be set to last a certain amount of time when the duration for playing the primary game is previously determined fixed, the frequency of triggering the secondary game at a fixed duration is inherently fixed and the number of triggering the secondary game is predetermined by the predetermined duration of the primary game. It would have been obvious to a person of ordinary skill in the art at

the time the invention was made to set the trigger event independently with the game outcome and set the frequency of the triggering the secondary game constantly in the game apparatus of Kaminkow as taught by Glavich in order to enhance excitement of the game and to control amount of award to be dispensed.

4. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminkow (US 2005/0026678) in view of Maya et al (US 2004/0077403).

Claims 18-21: Kaminkow discloses an electronic gaming apparatus comprising a processor; a primary game display; means for a player to make a wager; the processor randomly select and display indicia at the primary game display, if the outcome is a winning outcome, issue an award (Fig. 7; paragraphs 0029, 0031 and 0035); Kaminkow further discloses that a mechanical secondary game display separated from the primary game display displays awards prior to the selection of the secondary game trigger condition, and that the secondary game identifies the selection of award and awards the player would have been known in the art (paragraphs 0005). Kaminkow does not explicitly disclose randomly select between the secondary trigger and no trigger condition independently of the primary game outcome. However, Maya discloses the claimed limitation (last 5 lines of paragraph 0077). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to randomly select triggering a secondary game without considering the primary game outcome in the game apparatus of Kaminkow in order to randomly provide bonus game even to the non-winning player in the primary game to encourage play to the player who loses the primary game.

Response to Arguments

5. Applicant's arguments filed 9/30/05 have been fully considered but they are not persuasive.

In response to applicant's arguments in page 6 through page 8, Maya does not explicitly disclose that the "random award" occurs during the primary game. For the sake of argument, even though the "random award" taught in paragraph 0077 happens during the primary game, the "random award" does not depend on the primary game outcome because the award just is "randomly" triggered. Since the award is randomly provided, it can not depend on any outcome. Further, since Maya discloses including a processor for executing the program code and instructions, and since Maya discloses triggering award randomly, Maya obviously discloses selecting triggering a secondary game randomly by the processor.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, (for formal communications; please mark
"EXPEDITED PROCEDURE")

Hand-delivered responses should be brought to Crystal Plaza II,
Arlington, VA Second Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

kn
Date: December 9, 2005



Kim Nguyen
Primary Examiner
Art Unit 3713